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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/040,049
Filing Date: November 07, 2001
Appellant(s): MAZZARA ET AL.

Frank C Nicholas
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 10, 2006 appealing from the Office action mailed March 15, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2001/0011033	YAMASHITA	8-2001
6,748,246	KHULLAR	6-2004
6,741,870	HOLMSTROM ET AL.	5-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 25, 34, 37, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamashita (US 2001/0011033 A1).

Regarding claims 25, 37, and 46, Yamashita discloses a method, a computer usable medium, and a system for connecting to a network, the method comprising:

- receiving a network connection request at a system master (paragraph 0051);

- determining availability of at least one embedded device, the embedded device embedded in a vehicle, and at least one portable network access device, based on the network connection request (paragraphs 0052-0053);
- determining capability of the at least one embedded device and at least one portable network access device based on the determined availability (paragraph 0034);
- initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination (fig. 3, boxes S204 or S202 and its descriptions).

Regarding claim 34, Yamashita discloses the method of claim 25 as described above. Yamashita also discloses wherein receiving a network connection request comprises establishing a link between the embedded device and the portable network access device (fig. 3, boxes S201, S203 and its descriptions).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26, 33, 35, 38, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 2001/0011033 A1).

Regarding claims 26, 35, and 38, Yamashita discloses the method, and computer usable medium of claims 25, and 37 as described above, except wherein the system master is the embedded device. The Examiner notes that even though Yamashita does not explicitly or specifically disclose the system master is the embedded device. However, it would be obvious to one skilled in the art to simply design or implement a portable device that could be placed in a vehicle. Hence, this claimed feature is not novel.

Regarding claims 33, and 45, Yamashita discloses the method, and computer usable medium of claims 25, and 37 as described above, except wherein the type of service is analog communication, digital communication, satellite communication, and global system for mobile communication. The Examiner, however, takes Official Notice regarding the different types of services as claimed above because it is well known in the art to use at least any one of those types in communicating or connecting between devices.

5. Claims 27-32, and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 2001/0011033) in view of Khullar (US – 6,748,246 B1).

Regarding claims 27, and 39, Yamashita discloses the method, and computer usable medium of claims 25, and 37 as described above. Yamashita, however, fails to disclose wherein the capability determination is based on factors selected from the

group consisting of battery life viability, relative signal strength indication, service availability, type of service and call state.

In a similar endeavor, Khullar discloses a method and apparatus for selecting an access technology in a multi-mode terminal. Khullar also discloses wherein the capability determination is based on factors selected from the group consisting of battery life viability (col. 4, lines 3-5), relative signal strength indication (col. 4, lines 32-45), service availability (col. 4, lines 17-22), type of service and call state (col. 4, lines 22-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the listed factors above in order to determine the ability to make a connection or service, and make the communication more reliable and efficient.

Regarding claims 28, and 40, Yamashita, and Khullar disclose the method, and computer usable medium of claims 27, and 38 as described above. Khullar also discloses wherein the battery life viability is based on a power state and a power life (col. 4, lines 1-4).

Regarding claims 29, and 41, Yamashita, and Khullar disclose the method, and computer usable medium of claims 27, and 38 as described above. Khullar also discloses determining a calibrated threshold for the battery life viability (col. 6, lines 11-32).

Regarding claims 30, and 42, Yamashita, and Khullar disclose the method, and computer usable medium of claims 29, and 41 as described above. Khullar also

discloses determining the battery life viability if the calibrated threshold is exceeded (col. 6, lines 11-32).

Regarding claims 31, and 43, Yamashita, and Khullar disclose the method, and computer usable medium of claims 30, and 37 as described above. Khullar also discloses determining a calibrated threshold for the received signal strength indication (col. 4, lines 32-45).

Regarding claims 32, and 44, Yamashita, and Khullar disclose the method, and computer usable medium of claims 31, and 43 as described above. Khullar also discloses determining the received signal strength indication if the calibrated threshold is exceeded (col. 4, lines 32-45).

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 2001/0011033 A1) in view of Holmstrom et al. (US – 6,741,870 B1).

Regarding claim 36, Yamashita discloses the method of claim 25 as described above, except retrying the connection initiation if connection was not established.

In a similar endeavor, Holmstrom discloses a method and system for selecting communication media. Holmstrom also discloses retrying the connection initiation if connection was not established (abstract, and col. 3, lines 1-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamashita's invention and include the step of retrying the connection so that the system could make communication between devices.

(10) Response to Argument

The § 112 rejections

Applicant's arguments, see pages 10-11, filed July 10, 2006, with respect to claims 25, 37 and 46 have been fully considered and are persuasive. The rejection of claims 25, 37 and 46 has been withdrawn.

The § 102 rejections as anticipated by Yamashita

The Appellant argues at the second paragraph of page 12 that Yamashita does not disclose "initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination". At most, Yamashita discloses determining whether to connect to a network using a first or second radio communication section (radio communication sections 1, 2) based on a determination of whether the vehicle is in 'high speed transit'."

The Examiner respectfully disagrees with the statement above because firstly Yamashita teaches or suggests at paragraph 0052 to determine if both radio communication sections are standby (step S201), in which it means that **determining if both radio communication sections (communication sections 1 and 2) are available**. Therefore, this step taught by Yamashita reads on the step of determining availability of at least one embedded device, and at least one portable network access device of the claimed limitation. Yamashita also teaches or suggests that the CPU 3 detects a signal indicating that the mobile communications apparatus (i.e., communication section 2) is in an automobile (i.e., communication section 2 is

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available). Secondly, the CPU 3 determines that the communication during high speed transit is possible if desired (see paragraphs 0034, and 0063). This determination is considered as an ability to communicate or the capability to communicate; **that is also a capability determination.**

Hence, the Examiner broadly interprets that when the mobile communications apparatus (communication section 2) is plugged in the battery car, and detected by the CPU 3, **means that the communication section 2 is available or the availability determination** and the possibility of utilizing the communication during high speed transit **is the capability determination based on the determined availability or based on the availability of communication section 2.**

Therefore, it is clear to one skilled in the art that Yamashita teaches or suggests determining capability of the at least one embedded device and at least one portable network access device when at least one or the other is available, and initiating a connection to the network based on the determined capability.

The § 103 rejections over Yamashita

The Appellant argues at page 13 that claims 26, 33, 35, 38, and 45 are allowable because of the same arguments set forth in independent claims 25 and 27.

In response, the same explanation above is applied.

The § 103 rejections over Yamashita in view of Khullar

The Appellant argues at page 13 that claims 27-32 and 39-44 are allowable because of the same arguments set forth in independent claims 25 and 27.

In response, the same explanation above is applied.

Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yamashita discloses an apparatus and method for mobile communications. More specifically, Yamashita teaches or suggests determining capability of the cordless system and the cellular systems, and based on the determination, then an appropriate connection would be made. On the other hand, Khullar discloses a method and apparatus for selecting an access technology in a multi-mode terminal (i.e., to select a better technology or system over the second alternative technology or system of the multi-mode terminal based on the capability determination.) Hence, it would have been obvious to one skilled in the art at the time of the invention to combine Yamashita with Khullar in order to achieve a desired functionality (see col. 1, lines 61-65).

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The § 103 rejections over Yamashita in view of Holmstrom

The Appellant argues at page 14 that claim 36 is allowable because of the same arguments set forth in independent claim 25.

In response, the same explanation above is applied.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Wayne Cai

Conferees:



Duc Nguyen (SPE)



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